

REMARKS

In the Office Action dated July 14, 2004 ("Office Action"), claims 1 and 3-25 were rejected. Claims 13 and 14 stand rejected under 35 U.S.C. §112, second paragraph. Claims 1, 3-9, 12, 15, 19-21, and 24 also stand rejected under 35 U.S.C. §103 over U.S. Patent No. 5,061,481 to Suzuki et al. ("Suzuki '481") in view of U.S. Patent No. 4,970,252 to Sakuta et. al ("Sakuta '252"). Claims 1, 8, 9, 12, 20-21 and 24 stand rejected under 35 U.S.C. §103 over U.S. Patent No. 5,496,554 to Mellul et. al ("Mellul '544") in view of the Sakuta '252 patent. Claims 1, 8, 10, 11 and 20-24 stand rejected under 35 U.S.C. §103 over U.S. Patent No. 6,436,413 B1 to Gers-Barlag et al. ("Gers-Barlag '413") in view of the Sakuta '252 patent. Claims 1 and 15-18 stand rejected under 35 U.S.C. §103 over U.S. Patent No. 6,503,519 to Sakuta ("Sakuta '519") in view of the Sakuta '252 patent. Claims 1, 3, 13 and 14 stand rejected under 35 U.S.C. §103 over U.S. Patent No. 6,395,857 B1 to Suzuki et. al ("Suzuki '857") in view of the Sakuta '252 patent. Finally, Claim 25 stands rejected under 35 U.S.C. §103 over the Suzuki and Sakuta patents in view of U.S. Patent No. 6,121,373 ("Starch '373") to Starch.

In response, Applicants have amended claim 13. This amendment when considered with the remarks set forth below is deemed to place the application in condition for allowance. Claims 1 and 3-25 remain pending for continued examination. Withdrawal of the rejection of claims 1 and 3-25 is respectfully requested.

Rejection under 35 U.S.C. §112, Second Paragraph

Claims 13 and 14 stand rejected for indefiniteness as depending on a cancelled claim (Claim 13, depending on Claim 2) and as depending on an indefinite claim (Claim 14, depending on Claim 13). See Office Action at page 2.

In response, Applicants have amended claim 13 so as to depend on Claim 1. Claim 13, and, by extension, Claim 14, now depend on Claim 1. Applicants respectfully submit that this amendment cures the rejection made by the Examiner. Therefore, withdrawal of the rejection is respectfully requested.

Rejection Under 35 U.S.C. §103

1. Rejection of Claims 1, 3-9, 12, 15, 19-21 and 24 under 35 U.S.C. §103

Claims 1, 3-9, 12, 15, 19-21, and 24 stand rejected as obvious over Suzuki '481 in view of Sakuta '252. The Examiner states that it would be obvious for one of ordinary skill in the art to use the low-viscosity silicone oil disclosed in Sakuta '252 (i.e., methyltris(trimethylsiloxy)silane ("M3T")) as found in Example 6) in the cosmetic composition of Suzuki '481. The Examiner rationale for this assertion is that Sakuta '252 teaches it is known to use M3T in cosmetic compositions. Alternatively, the Examiner contends that it is *prima facie* obvious to combine two compounds taught in the prior art for use for the same purpose.

Applicants respectively traverse this rejection since the Examiner's characterization of M3T as found in example 6 of Sakuta '252 is a bit erroneous. Contrary to the Examiner contention, M3T (taught as low-viscosity silicone oil (D) in the Sakuta '252) is not a component of the disclosed cosmetic composition but is merely a reaction solvent (i.e., diluent) for the addition polymerization process used to

prepare the cosmetic product. *See e.g., Sakuta '252* at column 5, lines 9-19. Thereafter, the polymerization product (i.e., polymer) swells in the presence of the low-viscosity silicone oil (D). *See* column 5, lines 57-63 (which refers to the polymerization product as component (I)). However, the low-viscosity silicone oil (D) is then displaced from the polymerization product (i.e., component 1) by swelling the polymerization product with a saturated hydrocarbon oil, which is referred to as component (II), in order to obtain a transparent oily paste as a final product. *See* Column 5, line 65 – column 6, line 6. Thus, it will be clear to one skilled in the art that the cosmetic end-product (an oily, transparent paste) does not contain M3T as alleged by the Examiner.

Turning to example 6, it is clear from a reading of the specification that M3T is only being used as a diluent in the polymerization reaction and is not a component of the cosmetic end-product. Example 6, at column 9, lines 34-44, recites the description on the preparation of the polymerization product (i.e., component (I)) as previously described in the specification:

The procedure of Example 1 was repeated to obtain a polymerization product, except that the charged materials were replaced with 320 g of dimethylhydrogensilyl-terminated dimethylpolysiloxane (average molecular weight: 2,870; Si--H: 2.5 mol %), 616 g of trimethylsilyl-terminated dimethylvinylpolysiloxane (average molecular weight: 5,000; vinyl group content: 1.5 mol %) and 1,405 g of methyltris(trimethylsiloxy)silane (viscosity: 1.6 cBt). and 0.5 g of a 2 % chloroplatinic acid solution in isopropanol.

While this intermediate polymerization product is not described physically in example 6, example 1 does provide a physical description of the intermediate polymerization

product. Example 1 describes the intermediate polymerization product as “[a] white and soft powder. . . .” See Sakuta ‘252 at column 7, lines 28-29. Thus, from the description set forth in the examples, this product is not the cosmetic product alluded to by the Examiner.

At column 9, lines 44-52, example 6 then continues on to describe the addition of a saturated hydrocarbon (i.e., component (II) as described in the specification) to eventually obtain the end-product, which is a colorless and transparent composition:

In the same manner as in Example 1, an oily paste composition was prepared, except that 100 parts by weight of this polymerization product and 300 parts by weight of a saturated hydrocarbon oil ("Isozole 300"; boiling temperature range: 170 to 189.degree. C. product by Nippon Petrochemical Co., Ltd.) were mixed.

This composition had a colorless and transparent appearance, and had a viscosity of 150,000 cP.

From this description of example 6, it is clear that M3T is not a component of the cosmetic product. As a result, Applicants do not see how one skilled in the art would be motivated to use the M3T diluent of Sakuta ‘252 as a component of the cosmetic disclosed in Suzuki ‘481. There is nothing in Sakuta ‘252 that would motivate one skilled in the art to use M3T as a cosmetic component as taught in Suzuki ‘481. Rather, Sakuta teaches that M3T has a viscosity of 1.6 cSt and is used solely as a reaction solvent which is to be replaced with a saturated hydrocarbon oil. Column 6, lines 58-59 demonstrate that the final composition suitable for cosmetic use is mainly composed of saturated hydrocarbon oil. Thus, neither Sakuta nor the prior art teach that M3T and other low-viscosity silicone oils are art-recognized equivalents in the

cosmetics context. (See Office Action at 9). Further, the fact that M3T and other low-viscosity silicone oils are not art-recognized equivalents implies that use of M3T in the manner claimed in the pending claims is not simply a concomitant use of two conventional low viscosity silicone oils well-known in the cosmetic art. (See Office Action at 4). Withdrawal of the rejection is therefore respectfully requested.

Moreover, even assuming *arguendo* that there was motivation to combine the references, the cited prior art still does not teach or suggest the improved properties of a cosmetic achieved through the use of M3T as compared to other low-viscosity silicone oils. Specifically, Applicants have found that M3T offers improvements in performance over other low-viscosity silicone oils that is not taught or suggested by the cited prior art. The Examiner's attention is respectfully directed to example 1 and comparative example 1 of the present specification. *See* specification at pages 36-38. Example 1 and comparative example 1 differ in that the M3T used in example one was replaced with D5, which is decamethylcyclopentasiloxane. *See* specification at page 37, lines 17-20; *see also* page 2, lines 14-15. As the Examiner will note, decamethylcyclopentasiloxane is one of the preferred low-viscosity silicone oils specifically taught by Sakuta '252. *See* column 4, lines 29-31.

Based on the teachings of Sakuta '252, one skilled in the art would expect decamethylcyclopentasiloxane and M3T to be equivalents. However, as the table at the bottom of page 38 of the present specification shows, they are clearly not equivalents. As shown in the table, the inventive cosmetic composition of example 1 exhibited a durability of cosmetic coverage of 42 and a refreshing feel of 39. To the contrary, the comparative cosmetic composition of comparative example 1 exhibited a durability of

cosmetic coverage of 29 and a refreshing feel of 16. Such an improvement where none is expected is indicative of unexpected results and therefore nonobviousness. Withdrawal of the above rejection is once again respectfully requested.

2. Rejection of Claims 1, 8, 9, 12, 20-21, and 24 under 35 U.S.C. §103

As noted above, claims 1, 8, 9, 12, 20-21 and 24 stand rejected over Mellul '544 in view of Sakuta '252. Once again, Sakuta '252 is relied upon as allegedly teaching the use of M3T as a component of a cosmetic product. The Examiner states that

It would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified the composition in Mellul by substituting the low viscosity silicone oil with methyltris(trimethylsiloxy)silane as motivated by Sakuta ('252) because of the expectation of successfully producing a similar cosmetic composition.

Office Action at page 5.

Applicants respectfully submit that this rejection also fails for the exact same reasons as the rejection over Suzuki '481 in view of the Sakuta '252. First, Sakuta '252 does not teach or suggest in any way that M3T is useful as a component for a cosmetic product. M3T is only a residual component in the compositions disclosed in Sakuta '252, as Sakuta '252 only teaches that M3T is used as a solvent or diluent of an addition polymerization product. Further, Sakuta teaches that among low-viscosity silicones cyclic dimethylpolysiloxanes are particularly preferred (see Column 4, lines 33-35). Such cyclic dimethylpolysiloxanes as octamethyltetrasiloxane and decamethylcyclopentasiloxane (D4 and D5 in the present specification) are also expressly described in Suzuki '481. Thus a reading of Mellul in view of Suzuki and/or Sakuta by a person of ordinary skill in the art would not be motivated to use M3T as a

low-viscosity component of the claimed product. There is thus no motivation or suggestion to use M3T as a component of a cosmetic product.

Second, as previously noted, Applicants have also found that M3T provides an unexpected improvement over the other low-viscosity silicone oils specifically taught by Sakuta '252. In fact, while other low-viscosity silicone oils such as decamethylcyclopentasiloxane ("D5" as taught in the instant specification) and octamethylcyclotetrasiloxane ("D4" as taught in the instant specification) are taught as preferred, a careful reading of the instant specification discloses that the use of M3T solves important problems central to the use of D4 and D5 for cosmetic purposes. The problems of a low freezing point as found as D4 and lack of sufficient volatility as found in D5 (see the instant specification at page 2) are substantially mitigated by the use of M3T, as is shown in the table at page 38 of the specification.

An improvement where none is expected is an indicia of non-obviousness, and rebuttal evidence in the §103 context may properly include evidence that the claimed invention yields unexpectedly improved properties or properties not present in the prior art, as well as a showing that the claimed compound possesses unexpected properties. *See* Manual of Patent Examining Procedure, §2144.08 at 2100-152 (Eighth Ed., incorporating Revision No. 2). Here, the applicant has established a nexus between the use of M3T and unexpectedly improved properties of cosmetic compositions. *See* table at page 38 of the specification. Accordingly, consideration of the evidence presented in the present and March 16th amendments and in the instant specification at page 38, and withdrawal of the rejection is respectfully requested.

3. Rejection of Claims 1,8, 10, 11, and 20-24 under 35 U.S.C. §103

Claims 1,8, 10, 11, and 20-24 stand rejected under as obvious over Gers-Barlag '413 in view of the Sakuta '252. The Examiner states that it would be obvious for one of ordinary skill in the art to combine the low-viscosity silicon oil disclosed in the Sakuta '252 patent with the emulsion disclosed in the Gers-Barlag '413.

Applicants respectively traverses this rejection since the Gers-Barlag '413 is not prior art against the present application. Applicants respectfully point out according to the "Notice of Acceptance of Application under 35 U.S.C. 371 and 37 CFR 1.494 or 1.495" mailed June 20, 2002, present application is listed as being entitled to a priority date of August 30, 1999. The Gers-Barlag '413 effective U.S. filing date for 35 U.S.C. §102(e) purposes is also August 30, 1999. Thus, Gers-Barlag '413 does not pre-date the present application under 35 U.S.C. §102(e) and thus cannot serve as a §102(e) reference against the pending claims. Withdrawal of the rejection is thus respectfully requested.

4. Rejection of Claims 1 and 15-18 under 35 U.S.C. §103

Claims 1 and 15-18 stand rejected as obvious over Sakuta '519 in view of the Sakuta '252 patent. The Examiner states that it would be obvious for one of ordinary skill in the art to combine the low-viscosity silicon oil disclosed in the Sakuta '252 with cosmetic composition disclosed in the Sakuta '519.

Applicants respectively traverse this rejection on the grounds that the Sakuta '519 is not a reference against the present application since the present application is entitled to a priority date of August 30, 1999. To the contrary, Sakuta '519 has a U.S. filing date of June 23, 2000. Thus, Applicants do not see how Sakuta '519 can be a

reference against the present application. Withdrawal of the rejection is thus respectfully requested.

5. Rejection of Claims 1, 3, 13 and 14 under 35 U.S.C. §103

Claims 1,3, 13 and 14 stand rejected as obvious over Suzuki '857 in view of the Sakuta '252. The Examiner states that it would be obvious for one of ordinary skill in the art to combine the low-viscosity silicon oil disclosed in the Sakuta '252 patent with the cosmetic composition claimed in the Suzuki '857 patent.

The applicant respectfully traverses this rejection on the grounds that the Suzuki '857 is not a reference against the present application, which is entitled to a priority date of August 30, 1999. The effective U.S. filing date of Suzuki '857 is May 23, 2000. Thus, Applicants do not see how Suzuki '857 can be a reference against the present application. Withdrawal of the rejection is thus respectfully requested.

6. Rejection of Claim 25 under 35 U.S.C. §103

Claim 25 stands rejected as obvious in view of Suzuki and Sakuta '252, and further in view of Starch '373. The Examiner states that it would be obvious for one of ordinary skill in the art to have modified the composition disclosed by the Suzuki reference by adding the silicone emollient comprising trimethylsiloxysilicate as disclosed by the Starch '373 patent.

The applicant respectfully traverses this rejection on the grounds that this rejection fails for the exact same reasons as the rejection over Suzuki '481 in view of the Sakuta '252 patent. First, as previously noted, Sakuta '252 does not teach or suggest in any way that M3T is useful as a component for a cosmetic product. M3T is only a residual component in the compositions disclosed in Sakuta '252, as Sakuta '252

only teaches that M3T is used as a solvent or diluent of an addition polymerization product.

Second, Applicants have found that use of M3T as an integral component of a cosmetic composition yields unexpected results in sensory characteristics of cosmetic compositions utilizing M3T. *See generally* page 38 of the specification and further discussion at Paragraph 2, pp. 12-14 of this Amendment. One of ordinary skill in the art would not anticipate the unexpected results detailed at Page 38 of the specification from a combination of the Suzuki, Starch and Sakura references. Accordingly, withdrawal of the rejection is respectfully requested.

Applicants do not believe that any additional fees are due. However, if any additional fees are due, please charge such sums to our Deposit Account 50-1145.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Gerald Levy", is written over a horizontal line.

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